

REMARKS

Upon entry of the present amendment, Claims 1 to 13 remain in the application. No claims are canceled. Claims 10 to 14 are renumbered to Claims 9 to 13.

The Office Action of July 5, 1996 has been reviewed and the references carefully considered. In view thereof, the present amendment is submitted. By this response, the Applicant respectfully requests review and reconsideration of the claims.

THE INVENTION

The invention is a golf tee and a method of adjusting the golf tee to different heights. The golf tee has different sized body sections that are separable and may be reattachable. The top different sized section has a golf ball supporting concavity. The tee can be used both outdoors on natural grass and indoors on artificial turf.

STATEMENT OF THE REJECTION

Claims 1, 2, 3, 5, 8 and 12 -13 stand rejected under 35 USC Section 102(b) as being clearly anticipated by Thompson or McLeod.

Claims 6 and 7 stand rejected under 35 USC Section 102(b) as being clearly anticipated by Thompson.

Claims 4 and 11 stand rejected under 35 USC Section 103 as being unpatentable over Thompson in view of Carson. As to claim 4, the Examiner asserts that to make the golf tee of Thompson to have a pyramid shape would have been considered a mere design choice since golf tees in the art are constructed having a multitude of shapes. As to claim 10, it is asserted that to make the golf tee of Thompson of biodegradable material would have been considered obvious in view of the teachings of Carson since such would enhance grass growth as well as reduce litter due to lost tees.

Claim 10 also stands rejected under 35 USC Section 103 as being unpatentable over Thompson in view of Lettrich. The Examiner contends that to construct the tee of Thompson of plastic material would have been considered obvious in view of the teachings of Lettrich, since plastic has been found to be more resistant to breakage than tees made of wood.

THE REFERENCES

The Thompson patent 1,846,407 shows stackable same size sections, each section having a seat for the golf ball.

The McLeod patent 1,738,596 also shows stackable same size sections.

The Carson et al. patent 5,431,392 shows a decomposable organic tee having wedges interiorly to break up the tee.

The Lettrich patent 5,052,689 shows a plastic support to hold a golf tee. The support is cuttable to different heights.

The Middendorf patent 1,850,560 teaches an edible golf tee that can be nested with other edible golf tees.

The Whelan et al. patent 3,954,263 shows a golf tee made of grass seed and a carrier material.

The DiLaura patent 3,554,543 shows a synthetic foam disk golf tee.

The Wilkerson patent 5,242,161 teaches a device to customize golf tee height by placing the tee through the hollow middle of a device having detachable apparently same sized sections.

DISCUSSION

As the Examiner pointed out, the numbering of the claims omitted the number "9". Accordingly, Claims 10, 11, 12, 13 and 14 are herein renumbered to 9, 10, 11, 12 and 13 to correct this anomaly.

It is well established law that for a prior art reference to anticipate under the terms of 35 USC 102, every element of the claimed invention must be identically shown in a single reference. In re Bond, 910 F.2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990).

As to the rejection of claims 1, 2, 3, 5, 8 and 12 -13 under 35 USC Section 102(b) as being clearly anticipated by Thompson or McLeod, it is submitted that herein amended independent Claims 1 and 12 now contain a limitation of "different sized" sections. Neither Thompson nor McLeod show different sized sections. Rather, the references show exactly same sized sections. Moreover, the Thompson patent clearly states the units of the tee are identical or substantially identical. (Col. 1, line 38-40.)

Thompson also teaches that each section has a seat for the golf ball. McLeod teaches serrations on each section for holding the golf ball. In the instant invention, as claimed in Claim 1 only one section has a cavity for supporting a golf ball. Therefore, neither Thompson nor McLeod can anticipate Claims 1 and 12 as now claimed.

As Claims 2, 3, 5, 8 depend from independent Claim 1, they also contain the limitation of "different sized" sections. Claim 13 depends from independent Claim 12 and therefore also contains the limitation of the "different sized" sections. No new matter has been added as the different sized sections or units were clearly shown in the drawings as originally filed. The specification and abstract are herein amended to add the term "different sized".

With respect to the rejection of Claims 6 and 7 under 35 USC Section 102(b) as being clearly anticipated by Thompson, Claims 6 and 7 depend from amended Claim 1 which now contains the limitation of "different sized" section. As discussed above, Thompson teaches same sized units. The invention as presently claimed is not disclosed in the references the Examiner has cited; consequently, the rejections under 35 USC Section 102(b) for anticipation should be withdrawn.

As to the rejection of Claims 4 and 11 (there is an apparent discrepancy in the Office Action, this rejection seems to have had been mistyped as to claim 10 in the Office Action) under 35 USC Section 103 as being unpatentable for obviousness over Thompson in view of Carson et al., Applicant respectfully disagrees. Thompson as discussed above teaches same sized sections. The addition of Carson et al. to Thompson does not achieve the invention as claimed in Claim 4. This is because Carson et al. added to Thompson would result in a tee having same sized sections containing wedges therewithin.

Claim 4 claims a pyramidal body shape of different sized sections; in contrast, Thompson shows cylindrical same sized sections. Wedges emplaced within these same sized sections would not yield the invention as presently claimed in Claim 4. The Examiner states that the pyramid shape is an obvious design choice. The Applicant requests the Examiner to support the assertion of obvious design choice. In any event, the sections are not simply interchangeable, but must be selected as to the next size. Thompson teaches away from Claim 4 because the pyramid shape of Claim 4 is not same sized and it is more complex than the Thompson shape.

Claim 11 claims the tee as comprised from biodegradable material. Carson et al. added to Thompson does not cure the fact that Thompson teaches same sized sections. If anything, if these two references were combined, the result would be biodegradable same sized sections. Claim 11 does not claim same sized sections.

As to the rejection of Claim 10 under 35 USC Section 103 as being unpatentable for obviousness over Thompson in view of Lettrich, Lettrich adds a cuttable essentially cylindrical plastic support that fits around a tee. Thompson has same sized sections. The addition of Lettrich merely adds that a support that is fittable about a tee. Moreover, the

combination of the above references would teach away from the instant invention as claimed as different sized sections. Clearly, neither of these combinations teach the instant invention as now claimed in Claim 10 as having different sized sections.

It is respectfully pointed out that nowhere in the references themselves is there any teaching or suggestion to make the combination as suggested by the Examiner.

A reference should be considered as a whole and any portions arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc. v. Barnes-Hydro Curve, Inc. 796 F.2d 443, 230 USPQ 413 (Fed. Cir. 1986). None of these references singly or in combination teach the invention because the references teach same sized sections, while the invention as claimed uses different sized sections.

The other references although perhaps showing golf tees, are directed to stackable identical sections on identical shape and size.

Summarizing, it is observed that none of the references cited by the Examiner taken either individually or in combination, discloses the present invention. Therefore, the Claims in this application are not obvious over the cited references.

In view of the foregoing amendment to the claims and explanations, it is submitted that the Applicant has traversed and overcome all the rejections raised by the Examiner. Thus, it is respectfully requested that the rejections to the application be withdrawn and such action is respectfully solicited.

If the Examiner feels that prosecution of this application could be expedited or assisted in any way by a telephone conference, the Examiner is encouraged to telephone this attorney at the telephone number listed below.

Respectfully submitted:

A handwritten signature in cursive script, reading "Barbara M. Burns".

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